

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required. (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. §803). Applicants respectfully traverse the Restriction Requirement on the grounds that the Examiner has not carried the burden of providing sufficient reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct.

The Examiner states that Groups I and II “are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using.”

Where an application contains claims to a product, claims to a process specially adapted for (i.e., not patentably distinct from, as defined in MPEP §806.05(f)) making the product, and claims to a process of using the product, and the product claims are not allowable (i.e., not novel and nonobvious), restriction is proper between the process of making and the process of using. In this instance, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. Unless the Examiner can make a showing of distinctness between the process of using and the product (MPEP §806.05(h)), the product must also be joined with the process of using in grouping (B).

Determination of patentability of the product need not be made prior to making a requirement for restriction unless the requirement is based on a determination that the product claims are not allowable (MPEP §806.05(i)).

The Examiner states that the product is not allowable but has provided no information with regard to the determination of patentability of the product. Therefore, the Examiner’s

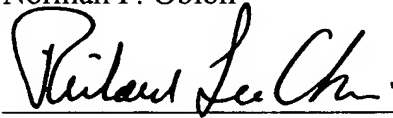
reasoning is nearly a restatement of the Examiner's conclusion that the two groups are patentably distinct. As the Examiner has provided insufficient reasons in support of this belief, the Examiner has not met the burden placed upon her, and accordingly, the restriction is believed to be improper and should be withdrawn.

Applicants submit this application is now in condition for examination on the merits and early notification of such action is earnestly solicited.

Respectfully submitted,

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